

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Before the Board of Patent Appeals and Interferences

AF/3644

In re Patent Application of

Atty. Dkt.: 540-204

C# M#

TIGHE et al

Group Art Unit: 3644

Serial No. 09/582,760

Examiner: G. Barefoot

Filed: June 30, 2000

Date: June 10, 2003

Title: AIRCRAFT STRUCTURE FATIGUE  
ALLEVIATION



Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

☐ Correspondence Address Indication Form Attached.

☐ **NOTICE OF APPEAL**

Applicant hereby appeals to the Board of Appeals from the decision dated \_\_\_\_\_ of the Examiner twice/finally rejecting claims \_\_\_\_\_ (\$ \_\_\_\_\_)

☐ An appeal **BRIEF** is attached in triplicate in the pending appeal of the above-identified application (\$ 320.00)

☐ Credit for fees paid in prior appeal without decision on merits

-\$ ( )

☒ A Second Supplemental reply brief is attached in triplicate under Rule 193(b)

(no fee)

☐ Petition is hereby made to extend the current due date so as to cover the filing date of this paper and attachment(s) (\$110.00/1 month; \$410.00/2 months; \$930.00/3 months; \$1450.00/4 months)

**SUBTOTAL** \$ 0.00

☐ Applicant claims "Small entity" status, enter 1/2 of subtotal and subtract

-\$ ( )

☐ "Small entity" statement attached.

**SUBTOTAL** \$ 0.00

Less month extension previously paid on

-\$ ( 0.00)

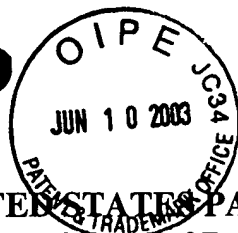
**TOTAL FEE ENCLOSED** \$ 0.00

Any future submission requiring an extension of time is hereby stated to include a petition for such time extension. The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our **Account No. 14-1140**. A duplicate copy of this sheet is attached.

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NIXON & VANDERHYE P.C.  
By Atty: Stanley C. Spooner, Reg. No. 27,393

Signature: \_\_\_\_\_



#24 / Suppl.  
Reply  
Brief  
Bentley  
12/2/03

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\* \* \* \* \*

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Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

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**FURTHER SUPPLEMENTAL REPLY BRIEF**

This Further Supplemental Reply Brief is responsive to the Examiner's comments mailed June 3, 2003 (otherwise not identified as having a specific paper number).

The Examiner states that "Appellant seems to imply that the examiner has not set forth a proper motivation for the combination of Makhonine and Bell." Appellant has not made any such implication and rather has clearly stated that the Examiner has failed to provide any evidence of motivation – see the Appeal Brief, pages 9-10, the Reply Brief, page 4, and the Supplemental Reply Brief, first full paragraph page 2, all specifically pointing out that the Examiner has failed to meet the Federal Circuit's requirement for establishing a reason or motivation for combining references.

The Examiner asserts that page 8 of the Examiner's Answer, line 3, provides the required "motivation" since the combination will "provide for automatic control in place

of human control" with the Examiner again relying upon a 45 year old Court of Customs and Patent Appeals case. Appellant has previously noted that it is improper for the Examiner to rely upon benefit of an unknown combination as a motivation for trying the unknown combination in the first place.

The Court of Appeals for the Federal Circuit has consistently held that there must be some reason of record for combining elements from separate references. Appellant has cited the *In re Rouffet* decision which clarifies this requirement and has pointed out that at no point during the prosecution of this patent application has the Examiner provided any motivation other than the 20/20 hindsight recognition that the combination of these elements provides a benefit, i.e. "provides for automatic control in place of human control."

Appellant has also previously attempted to point out to the Examiner that the *In re Venner* decision not only is a 45 year old decision by the predecessor court to the Court of Appeals for the Federal Circuit, it does not clearly elaborate upon the motivation requirements and certainly does not controvert the more recent decisions of the Court of Appeals for the Federal Circuit cited in appellant's Appeal Brief and Reply Brief. The current requirements for establishing motivation for a combination are expressed in the *In re Rouffett* case and the Examiner has failed to meet his burden of establishing a *prima facie* case of obviousness.

Consequently, the Examiner's continuing failure to point out any motivation for combining elements recited in appellant's independent claims or claims dependent thereon is a clear basis for reversal of the Examiner's conclusion of obviousness.

In view of the fact that the Examiner has continued to ignore the defects noted in appellant's Appeal Brief, Reply Brief and Supplemental Reply Brief, it is submitted that the rejection of claims 1-10 over the cited prior art is clearly in error and reversal thereof by this Honorable Board is respectfully requested.

Respectfully submitted,

**NIXON & VANDERHYTE P.C.**

By: 

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